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Christopher Charles McCormick

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DEMONT & BREYER, LLC
100 COMMONS WAY, Ste. 250
HOLMDEL, NJ 07733

EXAMINER

WRIGHT, PATRICIA KATHRYN

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/668,688
Filing Date: September 23, 2000
Appellant(s): MCCORMICK ET AL.

Wayne S. Breyer
For Appellant

EXAMINER'S ANSWER

Responsive to the order returning undocketed Appeal to Examiner mailed November 28, 2008, a replacement Examiner's Answer is set forth below. The previous Examiner's Answer mailed on May 30, 2008 is hereby vacated.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claims 20, 24, 26-29, 31-32, 34, 37 and 39 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schuller (US Patent no. 6,882,980).

Claims 22, 23, 25, 30, 35, 36, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuller (US Patent no. 6,882,980).

NEW GROUND(S) OF REJECTION

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schuller (US Patent no. 6,882,980). Although the limitations of claim 40 were addressed in the body of rejection under 35 U.S.C. 103(a) as being unpatentable over Schuller (US Patent no. 6,882,980) claim 40 was inadvertently left out of the status of the claims in the Final rejection (mailed October 26, 2007) and the Examiner's Answer (mailed May 30, 2008).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|---------|----------|--------|
| 6882980 | SCHULLER | 4-2005 |
|---------|----------|--------|

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 20, 24, 26-29, 31-32, 34, 37 and 39 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schuller (US Patent no. 6,882,980).

Schuller teaches a chemical product commerce network. Specifically, Schuller teaches a computer system with purchasers (clients) connected through a server to a database containing chemical data for chemicals to be purchased, and a purchasing system, where the clients can purchase batches of the chemicals in the database (e.g., raw materials; see col. 4, line 27, et seq.)

Schuller also teaches that the purchaser enter a requirement (i.e., target characteristic information) in the system (see col. 4, line 45, et seq.). The data system compares the requirement (target characteristic) to known product and formulation

characteristics (i.e., analyses) previously stored in a database 125 (see col. 4, lines 47-59).

With respect to the wherein clause in claims 20, 31 and 37 which requires that the analyses are obtained from testing facility in accordance to a uniform standard, it is expected that, in order to do the comparison the products are compared using a uniform standard for an accurate determination between the two analyses. However, if not, it would have been obvious to one of ordinary skill in the art to provide a uniform standard for an accurate determination between the two analyses.

With respect to the inclusion of a plurality of supplier's batch information being stored in the database as recited in claims 26-29, 32, 34, 39 and available for testing of those products, it would appear that Schuller anticipates this feature. See for example, where Schuller teaches multiple suppliers as well as multiple purchasers (column 3, line 14, et seq.) and multiple vendors contributing to the one database of product-related information (column 6, lines 56-67). As Schuller has already discussed independent testing by the intermediate, it would appear that such testing would have been available in this multiple vendor embodiment. However, if not, it would have been obvious to make such testing available in a multi-user/vendor system as an independent way to verify product information supplied, as well as to expand upon it.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included here can be found above.

Claims 22, 23, 25, 30, 35, 36, 38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuller.

Schuller does not specifically teach:

- Outputting statistics to a subscriber,
- Pricing below a normal selling price,
- Specifically providing no information about vendor to the purchaser, and
- Ranking products based on a criteria.

One of the advantages of a database, is the storing of historical data, as well as the ability to mine that data for all types of information, including trends. It would have been obvious to one having ordinary skill in the art to employ the services of a statistician to organize historical database information in a manner useful to the owner, as well as the users of that database.

With respect to sale items, it is in the best interest of a purchaser to determine the reasons for a sale on a particular item, and to ensure an acceptable level of quality for all his purchases. It would have been obvious to one having ordinary skill in the art to perform quality testing on any item offered for sale below an average selling price to determine if it meets the minimum standards required by the purchaser.

With respect to “white-washing” the vendor information, the best testing is done “blind” so that no name-brand influence can occur. It would have been obvious to one having ordinary skill in the art to test the products blindly in order to eliminate any brand name influence.

With respect to product ranking, again, this is one of the advantages of using a database. Data is easily reorganized to provide statistical analysis. It would have been obvious to one having ordinary skill in the art to list product analysis in an order from most desirable to least desirable given the specifications provided by the purchaser for easy viewing of the analysis. Such amounts to a ranking of the products.

(10) Response to Argument

Appellant's arguments filed February 25, 2008 have been fully considered but they are not persuasive.

Regarding the outstanding rejection of independent claims 20, 31 and 37 under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schuller (US Patent no. 6,882,980), Appellant argues that Schuller does not disclose the following steps:

1. a "requirement" as defined in Appellant's disclosure;
2. comparing...said requirement to analyses of batches...available for purchase;
3. wherein analyses are obtained from a testing facility that test sample...in accordance with a uniform standard that is established for the first chemical, and further wherein each batch that is available for purchase is analyzed by the testing facility.

Regarding point number 1, Appellant argues that Schuller does not receive a "requirement" as defined by the specification. Appellant argues that the term "requirement" is to be strictly construed to mean "the allowed ranges (from a

prospective purchaser's point of view) for the measured valves of the various chemical and physical characteristics that make up the uniform standard for a specialty chemical of interest". Appellant also states the phrase "uniform standard" is to be strictly construed to mean a "supplier-independent set of chemical characteristic or physical characteristics or both that are use to describe a chemical".

The Examiner respectfully disagrees with Appellant's arguments.

First, the Examiner notes that the phrase "uniform standard" is also defined generally as "chemical and physical characteristics and testing methods for each specialty chemical being sold...". See the page 11, lines 6-7 of Appellant's specification. Thus, the written description sets forth no consistent definition for the phrase "uniform standard".

By way of an overview, Schuller teaches a chemical product commerce network. Schuller teaches a computer system with purchasers (clients) connected through a server 120 to a database 125 containing chemical data for chemicals to be purchased and raw materials which can be purchased, and a purchasing system, where the clients can purchase batches of the chemicals in the database (e.g., raw materials; see col. 4, line 27, et seq.)

In response to appellant's argument that Schuller does not receive a "requirement" as defined by the specification, the Examiner respectfully disagrees. Schuller teaches that the purchaser enters a "requirement" (i.e., target characteristic information) in the system (see col. 4, line 45, et seq.). The data system compares the requirement (target characteristic) to known products, methods, and formulation

characteristics (i.e., analyses) previously stored in a database 125 (see col. 4, lines 47-59). As set forth in Schuller, the requirement (target characteristics) includes the binding and opacity properties of the product specified by a user, see col. 4, lines 46-59. Furthermore, the Examiner asserts that the Schuller binding and opacity properties of the product fall within appellant's meaning of the term "requirement". That is, the binding and opacity properties for a product of Schuller must inherently include information on allowed ranges (from a prospective purchaser's point of view) for the measured values of the various chemical and/or physical characteristics that make up the uniform standard (i.e. supplier independent set of chemical or physical characteristics used to describe a chemical or testing methods"). In other words, the product must fall within some specified ranges otherwise it would not be acceptable for purchase by the prospective purchasers.

Regarding point number 2, appellant argues that Schuller does not teach a comparison between the requirement and the product the user wants to purchase. Appellant also argues that the user of Schuller's system is not purchasing an "existing batch of specialty chemicals" based on matching an analysis of the batch to the user's requirement.

In response to appellant argument that the system of Schuller fails to teach a comparison between the requirement and an existing product the user wants to purchase, the Examiner again asserts that Schuller does teach a system which receives a "requirement" (i.e., target characteristic information) from the user. The target characteristic information includes a range of properties such as, binding and opacity,

which is then compared to the known properties stored in the database of Schuller.

This comparison can be done by measuring a difference between user-specified target characteristics and the stored characteristics (see col. 4, line 38 et seq.). Therefore, Schuller does in fact teach a data system which receives a requirement from a user and compares this requirement and the product the user wants to purchase.

In response to appellant's argument that the user of Schuller's system is not purchasing an "existing batch of specialty chemical's based on matching an analysis of the batch to the user's requirement, the Examiner disagrees.

According to one example, the system of Schuller can ship batches of existing raw materials (i.e., existing batch of specialty chemicals) to the user. Also Schuller teaches a system where raw materials from different warehouses are shipped to a product blending and manufacturing site, wherein the completed product (existing batch) is then shipped to the user, see for col. 4, lines 30 et seq. Thus, Schuller's system is for purchasing an "existing batch of specialty chemicals" (e.g., raw materials) based on matching an analysis of the batch to the user's requirement.

Regarding appellant's point 3, the wherein clause in claims 20, 31 and 37 requires that the analyses are obtained from testing facility in accordance to a uniform standard. As discussed above, it is expected that, in order to do the comparison in Schuller the products are compared using a uniform standard for an accurate determination between the two analyses (i.e., known product and formulation characteristics). However, if not, it would have been obvious to one of ordinary skill in

the art to provide a uniform standard for an accurate determination between the two analyses.

Appellant argues that claims 20, 22-32, 34-39 were improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Schuller. Appellant also states that as an alternative to section 102 the Examiner also rejected all the claims under section 103 as being obvious over Schuller. Appellant alleges that the Examiner offers no explanation as to why the subject matter recited in claims 20, 31, 37 is obvious in view of Schuller disclosure.

The Examiner respectfully disagrees. First, claims 20, 24, 26-29, 31-32, 34, 37 and 39 stand rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schuller. And claims 22, 23, 25, 30, 35, 36 and 38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Schuller.

The Examiner asserts that the rejection of claims 20, 24, 26-29, 31-32, 34, 37 and 39 under 35 USC 102/103 is proper since the interpretation of these claims may be in dispute. That is, giving the claims one interpretation, a rejection under 35 U.S.C. 102 is appropriate and given another interpretation, a rejection under 35 U.S.C. 103(a) is appropriate. See MPEP § 2111-2116.01 for guidelines on claim interpretation. Moreover, the Examiner has, in fact, stated what subject is in dispute and why it would be obvious to modify the reference. That is, the wherein clause in claims 20, 31, and 37 that requires that the analyses are obtained from testing facility in accordance to a uniform standard can be given different interpretations. However, it is expected that, in order to do the comparison the products are compared using a uniform standard for an

accurate determination between the two analyses in Schuller. However, if not, it would have been obvious to one of ordinary skill in the art to provide a uniform standard for an accurate determination between the two analyses in Schuller.

Also in dispute is the inclusion of a plurality of supplier's batch information being stored in the database as recited in claims 26-29, 32, 34, 39-40 and available for testing of those products. However, it would appear that Schuller anticipates this feature. See for example, where Schuller teaches multiple suppliers as well as multiple purchasers (column 3, line 14, et seq.) and multiple vendors contributing to the one database of product-related information (column 6, lines 56-67). As Schuller has already discussed independent testing by the intermediate, it would appear that such testing would have been available in this multiple vendor embodiment. However, if not, it would have been obvious to make such testing available in a multi-user/vendor system as an independent way to verify product information supplied, as well as to expand upon it.

Appellant also argues that there is no mention in Schuller of the core issues that motivated the development of Appellant's claimed invention. The Examiner asserts this is not germane to the issue and Schuller need not mention the same issues that motivated the development of Appellant's claimed invention.

Regarding the rejection of claims 25, 35, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuller. Appellant argues that these three dependent claims recite that the indicium of the identified batch that is output does not include the name of the supplier or the brand name of the specialty. Appellant states

that this ensures that the batches of specialty chemical that matches the requirement are not identified by the supplier's name or the product's trademark.

The Examiner disagrees with Appellant's argument. As set forth in the rejection of claims 25, 35, and 38 under 35 U.S.C. 103(a) as being unpatentable over Schuller, the Examiner admits that Schuller does not specifically teach providing no information about the vendor to the purchaser. As pointed out in the rejection, with respect to "white washing" the vendor information, the best testing is done "blind" so that no name-brand influence can occur. Thus, it would have been obvious to one having ordinary skill in the art to test or offer for sale the products blindly in order to eliminate any brand name influence. The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's answer.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR

Art Unit: 1797

41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

P. Kathryn Wright

/Jill Warden/

Supervisory Patent Examiner, Art Unit 1797

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Gregory L Mills/

Supervisory Patent Examiner, Art Unit 1700

Conferees:

/Pat Ryan/

Supervisory Patent Examiner, Art Unit 1795

/Jill Warden/

Supervisory Patent Examiner, Art Unit 1797